THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAULINA P. GARCIA, JOHN W. LEE, JOHN L. MARSHALL, DONALD A. McGOWAN, ANTHONY J. PUTTICK, THOMAS K. SPENCER, STEPHEN G. STROUD, STEPHEN J. TELFER and MICHAEL J. ZURAW

Appeal No. 95-4358
Application No. 08/052,212[1]

ON BRIEF

Before SOFOCLEOUS, GARRIS and WARREN, Administrative Patent Judges.

SOFOCLEOUS, Administrative Patent Judge.

DECISION ON APPEAL

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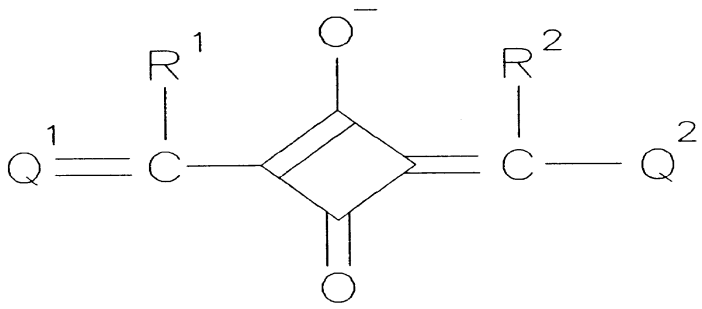
[1] Application for patent filed April 23, 1993. According to appellants, this application is a continuation-in-part of Application No. 07/696,222, filed May 6, 1991, now U.S. Patent No. 5,231,190, issued July 27, 1993.

This is an appeal from the final rejection of claims 1 to 13, 46 and 47, all the claims remaining in the application.

The subject matter on appeal is directed to a process for the preparation of a squarylium compound.

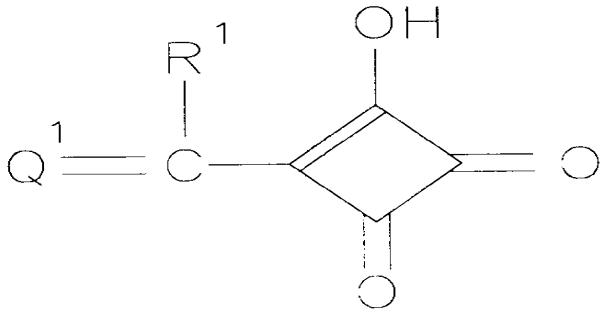
In the Brief, appellants urge that claims 7, 8, 46 and 47 and claims 1 to 6 and 9 to 13 stand or fall together as grouped. Claim 1 is sufficiently representative of the claims on appeal and reads as follows:

1. A process for the preparation of a squarylium compound of the formula:



wherein Q^1 and Q^2 are each independently an aromatic heterocyclic nucleus such that in the compounds of formulae $Q^1CH_2R^1$ and $Q^2CH_2R^2$ the methylene hydrogens are active hydrogens, and R^1 and R^2 are each independently a hydrogen atom or an aliphatic or cycloaliphatic group,

which process comprises reacting a squaric acid derivative of the formula:



wherein Q^1 and R^1 are as defined above, with a compound of the formula $Q^2CH_2R^2$.

The references relied upon by the examiner are:

Gravesteijn et al. (Gravesteijn)	4,508,811	Apr. 2, 1985
Detty	4,916,127	Apr. 10, 1990

Jerry March, Advanced Organic Chemistry: Reactions, Mechanisms, and Structure 326-27 (3d ed., John Wiley & Sons, New York 1985)

Claims 1 to 13, 46 and 47 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gravesteijn and Detty in view of March.

After having reviewed the references in light of the arguments raised by appellants, we find that we cannot sustain these rejections for the reasons set forth in appellants' Brief.

Appellants urge that the squaric acid derivatives of formula II of claim 1 are novel and unobvious compounds as shown by the allowance of claims to those compounds in appellants' parent application, now U.S. Patent No. 5,231,190. The claimed process prepares a known squarylium compound by reacting the novel and unobvious squaric acid derivative of formula II of claim 1 with a known heterocyclic compound. Under these circumstances, we agree with appellants that the claimed process is patentable. See In re Ochiai, 71 F.3d 1565, 1570, 37 USPQ2d 1127, 1131 (Fed. Cir. 1995); In re Brouwer, 77 F.3d 422, 425-26, 37 USPQ2d 1663, 1666 (Fed. Cir. 1995).

The examiner acknowledges that the prior art starting compounds of Gravesteijn and Detty are not identical to

appellants' squaric acid derivatives of formula II of claim 1. However, the examiner urges that the reactive portions of Gravesteijn and Detty's compounds are identical to the reactive portions of appellants' compounds. Essentially, it is the examiner's position that the references teach the generic process of preparing a squarylium compound, but do not teach the specific squaric acid derivatives of formula II of claim 1. On pages 5 and 6 of the Answer, the examiner shows how the process of Gravesteijn would yield a squaric acid derivative of formula II of claim 1 as a non-isolated intermediate. This, in our view, is not sufficient to show that the claimed process is obvious since Gravesteijn does not recognize or isolate the intermediate. Cf. Pfizer, Inc. v. International Rectifier Corp., 545 F.Supp. 486, 508, 207 USPQ 397, 414 (C.D. Cal. 1980), aff'd. 685 F.2d 357, 217 USPQ 39 (9th Cir. 1982).

REVERSED

MICHAEL SOFOCLEOUS)
Administrative Patent Judge)
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BRADLEY R. GARRIS) BOARD OF PATENT

Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
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